REMARKS:

Status Of Claims

Claims 1-41 were previously pending. Claims 42-45 have been added. Thus, claims 1-45 are currently pending in the application with claims 1, 10, 15, 23, 31, and 37 being independent.

Office Action

The Office Action Summary suggests that claims 1-40 were pending and stand rejected. However, Applicant believes that claims 1-41 were pending. Specifically, the Examiner has not addressed claim 41, and therefore Applicant understands claim 41 to have been allowed.

In the Office Action, the Examiner rejected claims 1-5, 7, 8, 10, 12, 17-22, and 37-40 under 35 U.S.C. 103(a) as being unpatentable over Turetzky et al., U.S. Patent No. 6,529,829, in view of Hakala et al., U.S. Patent No. 6,452,544. The Examiner also rejected claim 6 under 35 U.S.C. 103(a) as being unpatentable over Turetzky in view of Hakala in further view of Horvitz et al., U.S. Patent No. 6,601,012. The Examiner also rejected claims 9, 13-16, and 23-36 under 35 U.S.C. 103(a) as being unpatentable over Turetzky in view of Hakala and DeLorme et al., U.S. Patent No. 6,321,158. The Examiner also rejected claim 11 under 35 U.S.C. 103(a) as being unpatentable over Turetzky in view of Hakala in further view of Smith et al., U.S. Patent No. 6,374,179. Applicant respectfully submits that the currently pending claims distinguish the present invention from Turetzky,

Hakala, Horvitz, DeLorme, Smith, and the other prior art references of record, taken alone or in combination with each other.

Legal Discussion of Obviousness

Obviousness can be a problematic basis for rejection because the Examiner, in deciding that a feature is obvious, has the benefit of the applicant's disclosure as a blueprint and guide. In contrast, one with ordinary skill in the art would have no such guide, in which light even an exceedingly complex solution may seem easy or obvious. Furthermore, once an obviousness rejection has been made, the applicant is in the exceedingly difficult position of having to prove a negative proposition (i.e., non-obviousness) in order to overcome the rejection.

For these reasons, the law places upon the Examiner the initial burden of establishing a *prima facie* case of obviousness. If the Examiner fails to establish the requisite *prima facie* case, the rejection is improper and will be overturned. *In re Rijckaert,* 9 F.3d 1531, 1532, 28 U.S.P.Q.2d 1955 (Fed. Cir. 1993). Only if the Examiner's burden is met does the burden shift to the Applicant to provide evidence to refute the rejection.

In meeting this initial burden, the Examiner "cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention." *In re Fine,* 837 F.2d 1071, 1075, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988). Thus, the Examiner is required to perform the "critical step" of casting his or her mind back to the time of invention, to consider the thinking of one of ordinary skill in the art, guided only by

the prior art references and the then-accepted wisdom in the field. *See, e.g., W. L. Gore & Assoc., Inc. v. Garlock, Inc.,* 721 F.2d 1540, 1553, 220 U.S.P.Q. 303 (Fed. Cir. 1983).

Rejections on obviousness grounds also cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness. *In re Kahn,* 441 F.3d 977, 988, 78 U.S.P.Q.2d 1329 (Fed. Cir. 2006). The factual inquiry performed by the Examiner in issuing an obviousness rejection must be thorough and searching. *McGinley v. Franklin Sports, Inc.,* 262 F.3d 1339, 1351-52, 60 U.S.P.Q.2d 1001 (Fed. Cir. 2001). The prohibition against conclusory examination is as much rooted in the Administrative Procedure Act, which ensures due process and non-arbitrary decision-making, as it is in § 103. *In re Kahn*, 441 F.3d at 988.

Three criteria must be satisfied by the Examiner in order to establish a prima facie case of obviousness: (1) there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or combine their teachings; (2) there must be a reasonable expectation of success; and (3) the combination of references must teach or suggest all the claim limitations. *See* MPEP § 706.02(j), *citing In re Vaeck,* 947 F.2d 488, 493, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991). This "motivation-suggestion-teaching" requirement protects against the entry of hindsight into the obviousness analysis, a problem which § 103 was meant to confront. *In re Kahn,* 441 F.3d at 988.

Consequently, an Examiner's mere identification in the prior art of each individual

element claimed is insufficient to defeat the patentability of a claimed invention without a proper suggestion to combine or modify the elements. *In re Rouffet,* 149 F.3d 1350, 1357, 47 U.S.P.Q.2d 1453 (Fed. Cir. 1998). The fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Gordon*, 733 F.2d 900, 902, 221 USPQ 1125 (Fed. Cir. 1984).

In presenting the suggestion or motivation to combine prior art references, the Examiner may not resort to broad and conclusory statements; as such statements are not "evidence" of anything. *In re Kotzab,* 217 F.3d 1365, 1370, 55 U.S.P.Q.2d 1313 (Fed. Cir. 2000). The suggestion to make the claimed combination must be found in the prior art, not in the applicant's disclosure. *In re Vaeck,* 947 F.2d at 490. If the Examiner's proposed combination renders the prior art invention unsatisfactory for its intended purpose, or changes its principal of operation, there can be no suggestion or motivation to form the combination—and thus no *prima facie* case of obviousness. *See* MPEP § 2143.01*; In re Gordon*, 733 F.2d at 902.

Claim 1 recites "providing a first device including a triangulation positioning functionality", "providing a second device … separate from the first device, the second device including a dead reckoning positioning functionality", and "resolving a position of one of the first and the second devices, wherein resolving the position includes using the dead reckoning positioning functionality and the triangulation positioning functionality".

In contrast, as previously argued, Turetzky's dead reckoning system is integral to his

GPS enabled device and the two are simply not physically separable, and therefore Turetzky simply fails to teach two separate devices working together to resolve a position using both triangulation and dead reckoning. Turetzky actually teaches just the opposite, and actually teaches a preference to combine multiple components on one integrated circuit. It should be noted that Turetzky does teach a GPS system 100 and cellular phone system 120, which are taught as being co-located. Therefore, the most that one might infer would be that Turetzky's cellular phone system 120 might be separable from his GPS system 100. However, that doesn't change the fact the Turetzky teaches his GPS system 100 having both GPS functionality and dead reckoning functionality. Thus, Turetzky is not only completely devoid of any suggestion of two separate devices, one with triangulation functionality and one with dead reckoning functionality, but Turetzky actually teaches away from such separation of functionality.

Hakala, on the other hand, only teaches one navigation device, in this case a GPS device. Hakala is completely void of any suggestion of dead reckoning functionality at all. Therefore, it cannot be said that Hakala suggests two separate devices, one with triangulation functionality and one with dead reckoning functionality, as claimed in claim 1.

Furthermore, as previously argued, the prior art references made of record do not supply any suggestion or motivation to make the Examiner's proposed modification. Rather, as discussed above, Turetzky actually teaches away from such modification and Hakala doesn't even teach enough to be pertinent to this prong of a *prima facie* case of obviousness.

In summation, neither Turetzky nor Hakala teach "providing a second device ... separate from the first device, the second device including a dead reckoning positioning functionality" where the first device includes "a triangulation positioning functionality". Furthermore, as previously argued, the prior art references made of record do not supply any suggestion or motivation to make the Examiner's proposed modification. Thus, no combination of Turetzky and/or Hakala discloses, suggests, or makes obvious "providing a first device including a triangulation positioning functionality" and "providing a second device to communicate with the first device, but separate from the first device, the second device including a dead reckoning positioning functionality", as claimed in claim 1. As a result, the Examiner has failed to establish a *prima facie* case of obviousness and the present rejections simply cannot be sustained.

Claim 2 recites "wherein the first device is a handheld multifunction device selected from a group of a Personal Digital Assistant (PDA) enabled device and a cell phone enabled device". Claim 2 depends from claim 1, which recites "providing a first device including a triangulation positioning functionality". Thus, claim 2 requires the cell phone or PDA itself to actually have triangulation functionality.

In contrast, as discussed above Turetzky merely teaches a GPS system 100 and cellular phone system 120 being merely co-located. Hakala actually shows his map device 120 being separate from his cellular telephone 130. Thus, no combination of Turetzky and/or Hakala discloses, suggests, or makes obvious "wherein the first device is a handheld multifunction device selected from a group of a Personal Digital Assistant (PDA)

enabled device and a cell phone enabled device", as claimed in claim 2.

Claim 5 recites "wherein providing the second device includes a rate gyro sensor". In contrast, the Examiner acknowledges that the cited prior art fails to teach this limitation. Rather, the Examiner asserts that a compass is equivalent to a rate gyro sensor. Applicant respectfully disagrees. A compass is simply not the equivalent of a rate gyro sensor. A compass provides an indication of orientation, but only when it is stable and not moving. In fact, a compass provides no useful information when it is moving. On the other hand, a rate gyro provides an indication of rate of turn, but only when it is moving. Thus, a rate gyro provides no useful information when it is stable, nor does it provide any indication of orientation. As a result, a compass and a rate gyro perform vastly different functions, in vastly different ways, resulting in vastly different results. It simply cannot be said that they are equivalents. Thus, no combination of Turetzky and/or Hakala discloses, suggests, or makes obvious "wherein providing the second device includes a rate gyro sensor", as claimed in claim 5.

Claim 10 recites "providing a first mobile device including a triangulation positioning functionality" and "providing a second mobile device to communicate with the first mobile device and physically separable therefrom, the second mobile device including a dead reckoning functionality that includes an orientation component and a distance detection component". Thus, claim 10 requires that one device have "triangulation positioning functionality" and another device be "physically separable therefrom" and have "dead reckoning functionality that includes an orientation component and a distance detection

component".

In contrast, as discussed above with respect to claim 1, Turetzky does not disclose two physically separable devices, one with triangulation capability and another with dead reckoning capability. In fact, Turetzky actually teaches away from such separability. As discussed above Hakala only teaches one navigation device and is completely void of any suggestion of dead reckoning functionality at all. Thus, Hakala simply cannot cure Turetzky's defects. As a result, no combination of Turetzky and/or Hakala discloses, suggests, or makes obvious "providing a first mobile device including a triangulation positioning functionality" and "providing a second mobile device to communicate with the first mobile device and physically separable therefrom, the second mobile device including a dead reckoning functionality that includes an orientation component and a distance detection component", as claimed in claim 10.

Claim 11 recites "wherein the method further includes using one of the triangulation positioning and dead reckoning positioning functionalities to calibrate the other one of the triangulation positioning and dead reckoning positioning functionalities".

In contrast, the Examiner acknowledges that Turetzky does not disclose this limitation. *See* page 10 of the Office Action. In order the cure this defect, the Examiner mistakenly asserts that Smith discloses such calibration. The Examiner supports his assertion by quoting from Smith. However, the cited passages, as well as Smith's entire disclosure, merely teach forming a "composite of position data". *See* Abstract. More specifically, Smith's "[p]osition service module 202 is disposed to receive position data and

aggregate position data from each of a plurality of navigational position sources 208". Column 5, lines 55-58. Advantageously, Smith's "[p]osition service module 202 also functions to identify erroneous position data from [the sources] and eliminate such erroneous position data from the composite position data 240". Column 5, lines 61-64.

However, at no point does Smith actually teach or suggest calibrating any of his navigational position sources 208. In fact, Smith does not even include any variation of the term "calibrate". Rather, the most that can be said for Smith is that he teaches "discarding certain position data". Column 6, line 1. Such discarding is clearly not analogous to, nor suggestive of, calibration. Therefore, Smith fails to disclose or suggest calibration, as claimed, and simply cannot cure Turetzky's defects. As a result, no combination of Turetzky, Hakala, and/or Smith discloses, suggests, or makes obvious "wherein the method further includes using one of the triangulation positioning and dead reckoning positioning functionalities to calibrate the other one of the triangulation positioning and dead reckoning positioning functionalities", as claimed in claim 11.

Claim 12 recites "retrieving navigation related data from a memory of the second mobile device and displaying the navigation related data on an integral display of the first mobile device". Claim 12 depends from claim 10. Thus, claim 12 not only requires the first and second device to be separable, but also requires that the second, dead reckoning device store navigation data and that the first, triangulation device display the navigation data. Thus, not only are GPS and dead reckoning functions separated, so too are the storage and display of navigation data.

In contrast, Turetzky discloses no such functionality. Turetzky does not even suggest the possibility of storing navigation data in one device and displaying that data on another separate device. Hakala, on the other hand, teaches displaying navigation data on a head mounted display, which has no triangulation functionality. As discussed above, Hakala is completely void of any suggestion of any dead reckoning functionality. In fact, Hakala teaches storing the navigation data on his triangulation device. Thus, neither Turetzky nor Hakala teaches, or can be said to suggest, the limitations of claim 12. As a result, no combination of Turetzky and/or Hakala discloses, suggests, or makes obvious "retrieving navigation related data from a memory of the second mobile device and displaying the navigation related data on an integral display of the first mobile device", as claimed in claim 12.

Claim 15 recites "tracking a location of a first device using a triangulation positioning functionality" and "using a second device to communicate with the first mobile device, that is physically separable therefrom, and that includes a distance determination component and an orientation component". Claim 16 further requires "wherein the method further includes operably coupling the first and the second devices to communicate with one another in a single vehicle". Thus, as in claims 1 and 10, claim 15 requires two physically separable units, one with triangulation capability and another with dead reckoning capability. Claim 16 expands on this and explicitly requires the two devices to communicate with one another.

In contrast, as discussed above with respect to claim 1, Turetzky does not disclose

two physically separable units, able to communicate with each other, one having triangulation capability and another having dead reckoning capability. As also discussed above, Hakala simply fails to teach any dead reckoning functionality.

As previously argued, DeLorme discloses a GPS receiver used ***interchangeably*** with a dead reckoning system, rather than together as claimed in claims 15 and 16. Specifically, DeLorme's PDA device 02,102 can accept ***either*** a GPS system 08 or a dead reckoning system, but not both. Therefore, DeLorme's GPS system simply cannot communicate with his dead reckoning system, as required by the claim limitations. In fact, DeLorme actually teaches away from using his GPS system and dead reckoning system together. As a result, no combination of Turetzky, Hakala, and/or DeLorme discloses, suggests, or makes obvious "tracking a location of a first device using a triangulation positioning functionality" and "using a second device to communicate with the first mobile device and physically separable therefrom that includes a distance determination component and an orientation component", as claimed in claim 15, or "wherein the method further includes operably coupling the first and the second devices to communicate with one another in a single vehicle", as claimed in claim 16.

Claim 17 recites "wherein the handheld, portable second device includes a cradle for the first device". Claim 17 depends from claim 15, and therefore claim 17 requires that the dead reckoning device provide a cradle for the triangulation device. The Examiner fails to specifically address the limitations of claim 17. In fact, none of the prior art references suggest any cradling, much less that claimed in claim 17. As a result, no combination of

Turetzky and/or Hakala discloses, suggests, or makes obvious "wherein the handheld, portable second device includes a cradle for the first device", as claimed in claim 17.

Claim 20 recites "wherein selecting between using the first and the second devices includes resolving which of the first and the second devices is providing a better set of position data". In contrast, neither Turetzky nor Hakala suggests any evaluation of whether a triangulation device is providing better data than a dead reckoning device, or visa versa. Thus, no combination of Turetzky and/or Hakala discloses, suggests, or makes obvious "wherein selecting between using the first and the second devices includes resolving which of the first and the second devices is providing a better set of position data", as claimed in claim 20.

Claim 23 recites "a first mobile device including a dead reckoning positioning component" and "a second mobile device removably situated in the first mobile device including a triangulation positioning functionality in communication with the first mobile device". In contrast, as previously argued, neither Turetzky, Hakala, nor DeLorme disclose a similar combination of functionality. Specifically, Turetzky fails to teach a device having triangulation functionality being removably situated in a device having dead reckoning functionality. Hakala, as discussed above simply fails to teach any device having any dead reckoning functionality at all. Finally, as discussed above, DeLorme's GPS and dead reckoning devices are used interchangeably, and therefore DeLorme actually teaches away from those devices communicating, much less one being "removably situated in" the other. As a result, no combination of Turetzky, Hakala, and/or DeLorme discloses,

suggests, or makes obvious "a first mobile device including a dead reckoning positioning component" and "a second mobile device removably situated in the first mobile device including a triangulation positioning functionality in communication with the first mobile device", as claimed in claim 23.

Claim 26 recites "wherein the first mobile device further includes a triangulation positioning functionality, and the second device further includes a dead reckoning positioning component". Since claim 26 depends from claim 23, claim 26 actually requires both devices to include both triangulation and dead reckoning functionality. In contrast, neither Turetzky, Hakala, nor DeLorme disclose two devices, communicating with each other that each include both triangulation and dead reckoning functionality. As a result, no combination of Turetzky, Hakala, and/or DeLorme discloses, suggests, or makes obvious the limitations claimed in claim 26.

Claim 29 recites "wherein the second mobile device is removably, physically interfaced to the first mobile device". As discussed above, Turetzky's GPS receiver is integral with his dead reckoning sensor, and are therefore not "removably, physically interfaced" to each other. As also discussed above, Hakala teaches no dead reckoning device at all. Finally, as discussed above, DeLorme's GPS system is interchangeable with his dead reckoning system, and therefore they are not interfaced with each other at all. As a result, no combination of Turetzky, Hakala, and/or DeLorme discloses, suggests, or makes obvious the limitations claimed in claim 29.

Claim 30 recites "wherein the first and second mobile devices are wirelessly

interfaced with one another". In contrast, as discussed above, Turezky's GPS receiver is integral with his dead reckoning sensor, and therefore not "wirelessly interfaced with one another". As also discussed above, Hakala teaches no dead reckoning device at all. Also as discussed above, DeLorme's GPS system is interchangeable with his dead reckoning system, and therefore not interfaced with each other at all. As a result, no combination of Turetzky, Hakala, and/or DeLorme discloses, suggests, or makes obvious the limitations claimed in claim 30.

Claim 31 recites "a first device having a processor, a memory, and a transceiver … including a positioning function", "a second device having a processor, a memory, and a transceiver to communicate with one another, the second device including a positioning functionality", "wherein the transceivers in the first and the second devices transmit navigation related data wirelessly between the first and the second devices", and "wherein the first and the second devices cooperate to resolve a position of the first and the second devices". As discussed at length above, no combination of Turetzky, Hakala, and/or DeLorme discloses, suggests, or makes obvious two separate positioning devices that wirelessly communicate with one another and cooperate to resolve a position, as claimed in claim 31. Specifically, as discussed at length, DeLorme's two positioning devices are ***interchangeable***, and therefore simply do not ***cooperate*** with each other at all. As a result, no combination of Turetzky, Hakala, and/or DeLorme discloses, suggests, or makes obvious the limitations claimed in claim 31.

Claim 37 recites "tracking a location of a first device using a triangulation positioning functionality", "using a second device that communicates with the first device and includes a cradle for the first device, a distance determination component, and an orientation component", and "using software operable on the first and the second devices for selecting between using the first and the second devices". Claim 38 further recites "wherein selecting between using the first and the second devices includes resolving which of the first and the second devices is providing a better set of position data".

In contrast, as discussed above, none of the cited prior art references teach two navigation devices that communicate with each other, much less one device cradling the other. Finally, as also discussed above, and at least partially because the prior art fails to teach such cooperation, the prior art likewise fails to teach software for selecting which device is providing better data. As a result, no combination of Turetzky, Hakala, and/or DeLorme discloses, suggests, or makes obvious the limitations claimed in claims 37 or 38.

Claims 42-45 have been added to further distinguish the present invention over the prior art. Support for these claims may be found, among other places, on pages 18 and 19. The remaining claims all depend directly or indirectly from independent claims 1, 10, 15, 23, 31, or 37, and are therefore also allowable.

As discussed above, a *prima facie* case of obviousness necessarily entails citation to prior art references that not only teach each and every claim limitation, but also provide some suggestion to combine their teachings. While knowledge generally available to one of ordinary skill in the art may provide the suggestion, such suggestion may not be based

on Applicant's disclosure. Furthermore, the prior art must still teach each and every claim limitation. Here, as discussed above, the prior art fails to teach each claim limitation and fails to provide any motivation for the Examiner's proposed modifications. As a result, as clearly indicated by case law, the present rejections simply cannot be sustained.

Any additional fee which is due in connection with this amendment should be applied against our Deposit Account No. 501-791. In view of the foregoing, a Notice of Allowance appears to be in order and such is courteously solicited.

Respectfully submitted,

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